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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,318	03/28/2001	James K. Cushing	P04481US1	4370

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EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3694

MAIL DATE	DELIVERY MODE
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11/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/819,318	Applicant(s) CUSHING ET AL	
	Examiner Ella Colbert	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28,30,52-58 and 64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28,30,52-58 and 64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-28, 30, 52-58 and 64 are pending. Claims 1 and 30 have been amended in this communication filed 8/10/07 entered as Response After Non-Final Action, Request for Extension of Time and New or Additional Drawings.
2. The objection to the Specification has been overcome by Applicants' amendment to the Specification and is hereby withdrawn.
3. The objection to the drawings has been overcome by Applicants' drawing replacement sheets and is hereby withdrawn.
4. The 35 USC 112, second paragraph rejections are hereby withdrawn in view of Applicants' amendment to claim 1.

Claim Rejections - 35 USC § 103

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-17 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,041,313) Gilbert et al, hereafter Gilbert alone.

Claim 1. Gilbert discloses, A new method for designing group retirement plans for prospective plan sponsors, eliminating the need for a sales representative in retirement plan design, the method comprising: providing a Web site hosted by at least one computer in communication with a computer network the Web site having a business logic component for merging a plan sponsor's business needs with retirement plan design (col. 12, line 3-col. 13, line 25); collecting information from the plan sponsor through the web site, the information relating to the plan sponsor's business objectives (col. 12, lines 42-67); analyzing the information using the business logic component (col. 13, lines 5-25); and Gilbert discloses generating a retirement plan with plan rules appropriate to the plan sponsor's business objectives (col. 4, line 64-col. 5, line 16). Gilbert does not expressly disclose the component is "a business logic component". However, Gilbert as best as can be understood as to what Applicants' mean by "a business logic component", Gilbert performs a type of business analysis with the employee information view. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a business logic component for the analysis of collected information and to incorporate in Gilbert in view of Gilbert's disclosure of a welcome "home page-main menu" in col. 12, lines 3-5 and a computer

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network including the Internet in col. 19, lines 44-53. Analyzing business information according to a retirement planning sponsor's objectives is old and well known in the art of sponsored retirement planning for employees. For example, contributing to the Government's Thrift Savings Plan (TSP) requires the collection of information from the government organization. Recently the Lifecycle Funds (L Funds) became part of the retirement plan design to enable an employee to select a year of retirement with the plan being designed according to the amount of risk the employee is willing to incur. To have business logic software (a component) for this purpose saves time and makes the analysis of information more timely and is a better means of performing an analysis of collected information.

Claim 2 Gilbert discloses, The method of claim 1 wherein the computer network is a wide area Network (col. 19, lines 44-49 and fig. 1).

Claims 3 and 30. Gilbert failed discloses, The method of claim 1 wherein the computer network is the Internet (col. 19, lines 44-55).

Claim 4 Gilbert discloses, The method of claim 1 wherein the group retirement plan is a defined contribution retirement plan (col. 16, lines 53-67 and fig. 50).

Claim 5. Gilbert discloses, The method of claim 1 wherein the information relating to the plan sponsor's business objectives includes one or more reasons of the plan sponsor for providing the retirement plan (col. 5, lines 8-16, lines 47-51, and col. 5, line 66 –col. 6, line 40).

Claim 6. Gilbert failed to disclose, The method of claim 5 wherein the one or more reasons for providing the retirement plan include attracting and retaining employees.

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Official Notice is taken that it is old and well known to use a retirement plan as one of the attractive features of an organization for purposes of retention of employees.

Attracting and retaining employees is one of the features used when employees apply for a job with an organization. If an organization can attract and retain employees, it is economical because to have to continue to train new employees is not cost effective for any organization. Employees look for a good retirement plan when interviewing with an organization.

Claim 7. Gilbert discloses, The method of claim 1 wherein the information relating to the plan sponsor's business objectives includes an identification of plan participants intended to benefit under the retirement plan (col. 7, lines 1-23 and lines 35-65).

Claim 8. Gilbert discloses, The method of claim 1 wherein the information relating to the plan sponsor's business objectives includes participant access to retirement accounts retirement (col. 9, lines 29-45).

Claim 9. Gilbert discloses, The method of claim 1 wherein at least one of the plan rules relates to plan participant eligibility (col. 5, line 66-col. 6, line 8).

Claim 10. Gilbert discloses, The method of claim 1 wherein at least one of the plan rules relates to plan sponsor contribution amounts under the retirement plan (col. 5, line 66-col. 6, line 8).

Claim 11. Gilbert discloses, The method of claim 1 wherein at least one of the plan rules relates to profit sharing contributions under the retirement plan (col. 5, lines 47-51).

Claim 12. Gilbert discloses, The method of claim 1 wherein at least one of the plan rules relates to vesting of participant contributions under the retirement plan (col. 6, lines 2-8 and col. 14, line 20-27).

Claim 13. Gilbert discloses, The method of claim 1 which at least one of the plan makes relates to loans offered under the retirement plan (col. 9, lines 29-45 and col. 13, lines 39-49).

Claim 14. Gilbert discloses, The method of claim 1 wherein the plan rules relate to participant eligibility, plan sponsor contribution amounts, vesting of plan sponsor contributions, and loans offered under the retirement plan (col. 5, line 66-col. 6, line 8 and col. 9, lines 29-45).

Claim 15. Gilbert discloses, The method of claim 1 further comprising the step of presenting to the plan sponsor one or more of the plan rules for review by the plan sponsor (col. 14, line 58-col. 15, line 3).

Claim 16. Gilbert discloses, The method of claim 15 further comprising the step of facilitating a selection of one or more alternative plan rules by the plan sponsor (col. 16, lines 44-62 and col. 17, lines 17-28).

Claim 17. Gilbert discloses, The method of claim 16 further comprising the step of presenting to the plan sponsor one or more business consequences corresponding to the selection of the one or more alternative plan rules (col. 17, lines 29-63).

Claim 28. Gilbert discloses, The method of claim 5 further comprising the step of facilitating a selection by the plan sponsor of one or more investment options for

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participants under the defined contribution retirement plan (col. 17, lines 17-26 –shows a list of investment options).

8. Claims 19-27 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,041,313) Gilbert et al, hereafter Gilbert as applied to claims 1-18 and 28 above, and further in view of (US 6,064,986) Edelman.

Claim 18. Gilbert failed to disclose, The method of claim 1 further comprising the step of generating an application for a retirement plan contract based upon the plan rules.

Edelman discloses, The method of claim 1 further comprising the step of generating an application for a retirement plan contract based upon the plan rules (col. 21, lines 6-52).

Claim 19 Gilbert failed to disclose, The method of claim 18 further comprising the step of electronically transmitting to the plan sponsor the application. Edelman discloses, The method of claim 18 further comprising the step of electronically transmitting to the plan sponsor the application (col. 22, line 52- col. 23, line 2).

Claim 20. Gilbert failed to disclose, The method of claim 19 wherein the application is adapted to be executed and electronically submitted by the plan sponsor to apply for the retirement plan contract. Edelman discloses, The method of claim 19 wherein the application is adapted to be executed and electronically submitted by the plan sponsor to apply for the retirement plan contract (col. 23, lines 10-21).

Claim 21. Gilbert failed to disclose, The method of claim 18 further comprising the step of generating a service agreement for the retirement plan. Edelman discloses, The

method of claim 18 further comprising the step of generating a service agreement for the retirement plan (col. 25, lines 37-53).

Claim 22. Gilbert failed to disclose, The method of claim 21 further comprising the step of electronically transmitting to the plan sponsor the service agreement. Edelman discloses, The method of claim 21 further comprising the step of electronically transmitting to the plan sponsor the service agreement (col. 25, lines 18-36).

Claim 23. Gilbert failed to disclose, The method of claim 22 wherein the service agreement is to be adopted and electronically submitted by the plan sponsor. Edelman discloses, The method of claim 22 wherein the service agreement is to be adopted and electronically submitted by the plan sponsor (col. 24, line 45-col. 25, line 53).

Claim 24. Gilbert failed to disclose, The method of claim 20 further comprising the steps of generating an adoption of plan document. Edelman discloses, The method of claim 20 further comprising the steps of generating an adoption of plan document (col. 25, lines 37-53).

Claim 25. Gilbert failed to disclose, The method of claim 24 further comprising the step of electronically transmitting to the plan sponsor the adoption of plan document.

Edelman discloses, The method of claim 24 further comprising the step of electronically transmitting to the plan sponsor the adoption of plan document (col. 25, lines 37-53).

Claim 26. Gilbert failed to disclose, The method of claim 25 wherein the adoption of plan document is to be adopted and electronically submitted by the plan sponsor. Edelman discloses, The method of claim 25 wherein the adoption of plan document is to be

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adopted and electronically submitted by the plan sponsor (col. 24, line 45-col. 25, line 53).

Claim 27. Gilbert and Edelman failed to disclose, The method of claim 1 further comprising the steps collecting information from the plan sponsor relating to the plan sponsor's business and evaluating the information to determine whether the plan sponsor is eligible for the retirement plan design via the Web site. Official notice is taken that it is old and well known to collect information from a plan sponsor relating to the plan sponsor's business and evaluate the information to determine whether the plan sponsor is eligible for the retirement plan design via the Web site. Performing the collection for information for a retirement plan design via a Web site is a more economical and faster way to market the retirement plan design.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Gilbert to include this step. Inclusion of this step would enable a retirement planner to have a more economical and faster way to market the retirement plan design.

Claim 64. Gilbert failed to disclose, The method of claim 25 further comprising the step of electronically receiving an application fee from the plan sponsor. Edelman discloses, The method of claim 25 further comprising the step of electronically receiving an application fee from the plan sponsor (col. 23, lines 10-21).

It is old and well known to perform the method steps of claims 17-27 and 64 when seeking a retirement plan sponsor. It is well known that the retirement plan's sponsor rules are reviewed by the applicant, the application is submitted if the applicant

is interested, then a retirement plan agreement (contract) is signed, then the application is submitted to the plan sponsor, then the service agreement is sent to the plan sponsor, the agreement is adopted by both parties involved, and a fee is charged for the application.

Response to Arguments

10. Applicant's arguments filed 08/10/07 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: Gilbert et al does not teach any thing whatsoever about determining the optimum plan for any given plan sponsor. In Gilbert et al, the plan sponsor would need to determine in advance what features it wanted in its retirement plan and Gilbert et al does not disclose a method for automated design or recommendation of a retirement plan with plan rules optimized for the plan sponsor's business objectives. If anything, Gilbert et al teaches away from the present invention assuming the design of a particular plan without regard to a particular plan sponsor's business needs and objectives have been considered but is not persuasive. Response: Gilbert et al in col. 4, line 52-col. 5, line 24 discusses the setting up of a 401 (K) retirement plan by the employer and then the employee is setup in col. 12, line 3-col. 13, line 25 discusses the website. It is well known that a retirement plan is first designed by an employer and then offered to the employees of an organization.

Issue: no. 2: Applicants' argue: Applicants' respectfully submit that the Examiner has failed to make a prima facie case of obviousness has been considered but is not

persuasive. Response: See MPEP 2144 entitled "Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103: RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ART – RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT."

Further, the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied reference/references. In other words, the person having ordinary skill in the art has a level of knowledge apart from the content of the references. *In re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977); *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). A conclusion of obviousness is established "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Issue no. 3: Applicants' argue: The Edelman reference does not supply the missing elements from Gilbert et al and Edelman relates to a method of forming a trust and the system is implemented on forming a trust and the system is implemented on the individual level, rather than on a company-wide level. Therefore, there is not customizing of the plan fro the plan-sponsor and as such none of the cited references show, individually or in combination, a method for retirement plan design with rules optimized for the plan sponsor's business objectives as described in the claimed invention has been considered but is not persuasive. Response: Edelman discloses the claim limitations of claims 18-27, 30, and 64. The claim limitations of these claims do not claim a company-wide level. These claims claim a application for a retirement plan,

transmitting the plan to a sponsor, executing and electronically submitting by the plan sponsor to apply for the retirement plan, generating a service agreement, transmitting the service agreement to the plan sponsor, ...".

Conclusion: The Examiner carefully drew up a correspondence of each of Applicants' claimed limitations, one or more referenced passages in Gilbert and Edelman, what is well known in the art and what is obvious to one having ordinary skill in the art at the time the invention was made.

The Examiner is entitled to give limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Wednesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 29, 2007


ELLA COLBERT
PRIMARY EXAMINER